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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,158	11/17/2003	Yoshifumi Tanimoto	031730	9452
38834 7590 04/25/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
GAUTHIER, GERALD				
ART UNIT		PAPER NUMBER		
2614				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/713,158

**Applicant(s)**

TANIMOTO, YOSHIFUMI

**Examiner**

Gerald Gauthier

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 11/17/03, 01/27/06, 09/21/06

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of **claims 1-8** in the reply filed on March 14, 2008 is acknowledged.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-4, 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (US 7,333,472 B2) in view of Bach Corneliussen. (US 2005/0193123 A9).

Regarding **claim 1**, Yang discloses a communication terminal device (column 1, lines 18-20) comprising:

means for establishing a connection by a call control protocol with a destination device designated by an Internet Protocol telephone number [a user interface of a corresponding IP terminal transmits ID codes, such as a phone number, a port number and an IP address, column 5, line 62 to column 6, line14];

means for requesting a presentation of a plurality of communication protocols which the destination device can support over the connection [according to IP terminal connection information and call control information based on H.323/MGCP/SIP protocol procedures are presented, column 5,lines 26-40].

Yang fails to disclose selecting one communication protocol which the communication terminal device can support.

However, Bach Corneliussen teaches means for selecting one communication protocol which the communication terminal device can support from communication protocols presented by the destination device as a response to the request by the means for requesting [The client initiates the communication by sending a "setup"

message according to the standard call control protocol which has been selected, paragraph 0050]; and

means for communicating with the destination device over the connection by the communication protocol selected by the means for selecting [the suggested media set is accepted by the server by a message that also includes the media destination address to which the client is to send the media, paragraph 0050].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Yang using the teaching of selecting of communication protocol as taught by Bach Corneliussen.

This modification of the invention enables the system to select one protocol which the communication terminal device can support so that the user would use the data communication protocol of choice.

Regarding **claim 2**, Yang discloses a communication terminal device, further comprising: means for storing a communication protocol and an IP telephone number by associating one with the other [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65];

wherein when a communication protocol is stored in the means for storing by being associated with the IP telephone number of the destination device, the means for requesting does not request a presentation of a plurality of communication protocols which the destination device can support over the connection [The exchange interface

30 receives call origination information transmitted from the IP terminals 18 connected to the hub 20, or transmits call termination information to the IP terminals 18, column 4, lines 60-67], and the means for selecting selects the communication protocol associated with the IP telephone number of the destination device and stored by the means for storing [The exchange interface 30 receives call origination information transmitted from the IP terminals 18 connected to the hub 20, or transmits call termination information to the IP terminals 18, column 4, lines 60-67].

Regarding **claim 3**, Yang discloses a communication terminal device, wherein when a communication protocol is not stored in the means for storing by being associated with the IP telephone number of the destination device, the means for requesting requests a presentation of a plurality of communication protocols which the destination device can support over the connection, and the means for selecting selects one communication protocol which the communication terminal device can support from the communication protocols presented from the destination device [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65].

Regarding **claim 4**, Bach Corneliussen teaches a communication terminal device, further comprising: means for outputting to a prescribed destination, information indicating a failure in a communication with the destination device, when the means for

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selecting fails in selecting a communication protocol [the suggested media set is accepted by the server by a message that also includes the media destination address to which the client is to send the media, paragraph 0050].

Regarding **claim 6**, Bach Corneliussen teaches a communication terminal device, wherein the plurality of communication protocols include a Simple Mail Transfer Protocol (SMTP) and a Hyper Text Transfer Protocol (HTTP) [a standardized protocol such as for example the Hyper-Text Transfer Protocol (HTTP), paragraph 0020].

Regarding **claim 7**, Yang discloses a communication terminal device, further comprising: means for storing a communication protocol and an IP telephone number by associating one with the other; and means for operating by an operator [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65];

wherein stored contents of the means for storing can be edited, added, or deleted freely by a prescribed operation from the means for operating [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65].

***Allowable Subject Matter***

5. **Claim 8** is allowed.
6. **Claim 5** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ko is cited for call processing message converter in Internet protocol telephony.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.  
  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

/GG/  
April 25, 2008